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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/890,577	08/02/2001	Jean-Pascal Delay	Q65609	4707
7590	07/02/2004		EXAMINER	
Sughrue Mion Zinn Macpeak & Seas 2100 Pennsylvania Avenue NW Washington, DC 20037-3213			FOREMAN, JONATHAN M	
			ART UNIT	PAPER NUMBER
			3736	

DATE MAILED: 07/02/2004  
*4*

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/890,577	DELAY, JEAN-PASCAL
Examiner	Art Unit	
Jonathan ML Foreman	3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
 THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-6 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-6 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.
 

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)           | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ .                                   |

## DETAILED ACTION

### *Claim Objections*

1. Claim 2 is objected to because of the following informalities: claim 2, lines 27 – 28 states, “of the conduit, which conduit delimits . . .”. It is unclear if this is referring to the conduit of the body or of the immobilizing member. Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1 – 4 and 6 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,030,349 to Wilson et al.

In regards to claims 1 - 4 and 6, Wilson et al. discloses a device for manual control of a surgical guide (Col. 2, lines 6 – 9) having a body (32) with a conduit (34; Col. 4, lines 5 – 11), a member (20) for axially immobilizing the guide having a conduit that is displaceable between a position in which it immobilizes the guide and in which the conduits formed in the body and the immobilizing member are not aligned, and a position in which it releases the guide and in which the conduits formed in the body and the immobilizing member are aligned (Col. 5, lines 52 – 60), the device has a means for elastic return (18) of the immobilizing member to its immobilizing position (Col. 7, lines 7 – 24). The immobilizing member is considered by the examiner to be integral with the body in the two together form a unit. The body comprises a seat (36) for receiving the

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immobilizing member in the immobilizing position (Col. 5, lines 19 – 20). The seat forms an interruption of the conduit. Two spans are on each side of the seat for transverse support of the guide (Col. 6, lines 30 – 41). At rest, the immobilizing member is outside the seat (Col. 7, lines 19 – 22). Wilson et al. discloses an arm (18, Figure 5a) bearing the immobilizing member moveable relative to the body (Col. 5, line 66 – Col. 6, line 1).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,030,349 to Wilson et al.

In regards to claim 5, Wilson et al. discloses a device for manual control of a surgical guide (Col. 2, lines 6 – 9) having a body (32), an immobilizing member (20) and an arm (18) bearing the immobilizing member being engaged with a surface of the body (Col. 5, line 62 – Col. 6, line 1). However, Wilson et al. fails to disclose an elastically deformable connection between the body and the arm. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include an elastically deformable connection, such as an adhesive, between the body and the arm in order to keep the immobilizing member within the body. Additionally, it has been held that forming an article previously of two pieces into one piece involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure related to a device for manual control of a surgical guide. U.S. Patent No. 5,325,868 to Kimmelstiel and U.S. Patent No. 5,423,331 to Wysham. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan ML Foreman whose telephone number is (703) 305-5390. The examiner can normally be reached on Monday - Friday 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mary Beth Jones can be reached on (703) 308-3400. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

JMLF  
June 22, 2004

  
**MARY BETH JONES**  
**ACTING SUPERVISORY PATENT EXAMINER**